

REMARKS/ARGUMENTS

(Set forth an explanation of the changes made, such as, "In the specification, paragraph [0004] has been amended to correct minor editorial problems" or "In amended FIG. 15, the reference numeral "178" has been changed to --176-- in order to eliminate redundancy with previously used reference numerals. No new matter has been added.")

The Office Action mailed April 26, 2006, has been received and reviewed. Claims 3, 4, 6 through 26, and 28 through 33 are currently pending in the application. Claims 8 through 20 have been withdrawn as being drawn to a non-elected invention. Claims 3, 4, 6, 7, 21 through 26; and 28 through 33 stand rejected. Applicants have amended claims 4 and 21, and respectfully request reconsideration of the application as amended herein.

Information Disclosure Statement(s)

Applicants note the filing of an Information Disclosure Statement herein on January 24, 2005, and note that no copy of the PTO/SB/08 was returned with the outstanding Office Action. Applicants respectfully request that the information cited on the PTO-1449 be made of record herein.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 5,837,036 to Schleicher et al.

Claims 3, 6, 7, 21, 22, 24 through 26, and 33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schleicher et al. (U.S. Patent No. 5,837,036). Applicants respectfully traverse this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The 35 U.S.C. § 102(b) anticipation rejections of claims 3, 6, 7, 21, 22, 24 through 26, and 33 are improper because each and every element set forth in the claims is not described in Schleicher.

Schleicher is drawn to use of sulfur-containing compounds to filter or remove ozone from gases and the additional use of activated carbon to remove organic substances. The

process makes use of a filter containing an ozone-binding polymer and activated carbon. The sulfur-containing is specifically used to remove ozone from liquid and gas samples running through the filter system. More specifically, the ozone-binding polymers are used as powder, granules, fiber, fabric, felt, film, sintered material, foam or coatings on materials so that the “gas or liquid to be treated can be passed without trouble through the polymer material.” (Schleicher at col. 3, lines 18-29) (emphasis added) (See also Figs. 1 and 2). The sulfur-containing compounds are coated onto or soaked onto support materials that “are generally inorganic substances such as glass, silica gel, alumina, sand, ceramic masses, metal and organic substances such as plastics.” (Id. at lines 30-38) (emphasis added).

In contrast, independent claims 3, 4, 21, and 33 are drawn to a print medium comprising a sulfur-containing polymer inhibitor incorporated into the print medium. As described in the specification, print mediums include plain paper, copier paper, or photographic media. Schleicher does not describe a print medium comprising a sulfur-containing polymer inhibitor incorporated into the print medium. As such, Schleicher does not disclose each and every element of the claims. Claims 6, 7, 22, and 24 through 26 depend from and contain all of the limitations of dependent claims 4 and 21, and are likewise novel over Schleicher for the above-stated reasons. Applicants respectfully request withdrawal of the present rejection based on Schleicher.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent Application No. 2002/0071941 to Tsuchida et al. in View of U.S. Patent No. 5,837,036 to Schleicher et al.

Claims 3, 4, 6, 7, 21 through 26, and 28 through 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchida et al. (U.S. Patent Application No. 2002/0071941) in view of Schleicher et al. (U.S. Patent No. 5,837,036). Applicants respectfully traverse this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 3, 4, 6, 7, 21-26, and 28-33 are improper because the combined references do not teach all of the claim limitations and there is no motivation or suggestion to combine the references.

Independent claims 3, 4, 22, 28, and 33 all recite (or have been amended to recite) poly(phenylene sulfide) compounds or subsets thereof.

As previously discussed, Schleicher is drawn to use of sulfur-containing compounds to filter or remove ozone from gases and the additional use of activated carbon to remove organic substances. The process makes use of a filter containing an ozone-binding polymer and activated carbon. The sulfur-containing is specifically used to remove ozone from liquid and gas samples running through the filter system. More specifically, the ozone-binding polymers are used as powder, granules, fiber, fabric, felt, film, sintered material, foam or coatings on materials so that the "gas or liquid to be treated can be passed without trouble through the polymer material." The sulfur-containing compounds are coated onto or soaked onto support materials that "are generally inorganic substances such as glass, silica gel, alumina, sand, ceramic masses, metal and organic substances such as plastics." Schleicher does not describe a print medium comprising a sulfur-containing polymer inhibitor incorporated into the print medium.

Tsuchida is relied upon as disclosing an ink jet recording medium comprising a homopolymer or copolymer compound containing sulfur (abstract cited). As acknowledged by the Examiner, Tsuchida does not disclose that the sulfur containing compound is poly(phenylene sulfide). (Office Action at page 3). Furthermore, Tsuchida teaches away from the present invention, as it is limited to disclosure of specific compounds that include a sulfur atom and a polymer of a diallylamine type compound. (See, e.g., page 1 at para. [0010]). More specifically, these compounds are expressly identified as including carbon compounds along with sulfur. (See formulas (1)-(6) at paras. [0011] and [0012]). Thus, there is no suggestion or motivation to combine the compounds of Tsuchida with those of Schleicher. Likewise, the combination of Tsuchida (drawn to use of different types of sulfur containing compounds) with Schleicher (drawn to use of sulfur-containing compounds on

non-print media that are specifically used to remove ozone from liquid and gas samples running through the filter system) are drawn to entirely different arts and cannot be combined.

In fact, Tsuchida teaches away from the present invention. As discussed in para. [0026] of the present application, poly(phenylene sulfide) ("PPS") is a desirable compound because "[u]nlike many carbon compounds that include sulfur, PPS is odorless and, therefore, is advantageously used in the present invention." In contrast, the compounds taught in Tsuchida contain carbon compounds along with sulfur.

The nonobviousness of independent claims 3, 4, 21, 28 and 33 precludes a rejection of claims 6, 7, 22-26, and 29 through 32 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to claims 3, 4, 6, 7, 21-26, and 28-33.

ENTRY OF AMENDMENTS

The amendments to claims 4 and 21 above should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application.

CONCLUSION

Claims 3, 4, 6, 7, 21-26 and 28-33 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that

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additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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